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OFFICE OF PETITIONS

In re Application of :
Barton et al. :
Application No. 10/603,415 : DECISION DISMISSING
Filed: 24 June, 2003 : PETITION
Atty Docket No. CT-S090-1D US :

This is a decision in reference to the paper filed on 27 October, 2003, which is treated as a petition, requesting that the above-identified application be accorded a filing date of 24 June, 2003, with Page 66 of the specification as a part of the original disclosure.

On 24 June, 2003, the application was filed.

On 15 September, 2003, the Office of Initial Patent Examination (OIPE) mailed a Notice of Omitted Items in a Nonprovisional Application stating that the application had been accorded a filing date of 24 June, 2003, but that Page 66 of the specification (description and claims) appeared to have been omitted from the application.

In response, on 27 October, 2003, the present petition was filed. Petitioners concede that Page 66 was inadvertently omitted from the application, but states that the above-identified application is a division of Application No. 09/210,085, and incorporated the entire disclosure of the prior application by reference.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the

appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, however, petitioners neither assert that the missing page of specification was deposited on 24 June, 2003, nor request the 27 October, 2003 (the date the drawings were supplied), filing date.

MPEP 201.06(c) states that:

. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, Page 66 of the specification is not new matter if it was a part of the disclosure of the prior application.

Petitioner should file Page 66 as a preliminary amendment. If Page 66 is filed as a preliminary amendment, it will be reviewed by the examiner for new matter.

The application will be processed using only the application papers present on filing. The copy of Page 66 of the specification filed with the present petition will not be processed for examination, but will be retained in the application file.

As this petition was necessitated by applicants' filing error rather than an error on the part of the Office, a petition fee of \$130.00 will be charged to counsel's deposit account, No. 50-2641, as authorized in the petition.

The attorney docket number has been corrected as requested in the present petition. A corrected Filing Receipt is enclosed for petitioners' reference.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 24 June, 2003, using only the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cf: Corrected Filing Receipt